

PATENT
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Attorney Docket No. 14425US02

In the Application of:

Steven Koenck

Serial No. 10/787,443

Filed: February 26, 2004

For: MODULAR, PORTABLE DATA
PROCESSING TERMINAL FOR
USE IN A COMMUNICATION
NETWORK

Examiner: CHERY, DADY

Group Art Unit: 2616

Confirmation No.: 7829

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is
being sent via EFS-Web to the United
States Patent and Trademark Office on
November 7, 2007.

/Philip Henry Sheridan/

Philip Henry Sheridan
Reg. No. 59,918

PETITION TO EXPUNGE PAPERS UNDER 37 C.F.R. § 1.59(b)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On June 5, 2006, the Applicants mailed to the Commissioner for Patents a Litigation Statement Pursuant to MPEP § 2001.06(c) and Information Disclosure Statement (the "June 5 IDS"), copies of the four hundred and sixty-nine (469) printed references disclosed therein and the Form PTO-1449 (the "Related Papers"). The June 5 IDS and the Related Papers were submitted in connection with this patent application, U.S. Patent Application Serial No. 10/787,443, Attorney Docket No. 14425US02. The references submitted in the June 5 IDS were either cited, produced or relied upon by Qualcomm, Inc., during the following lawsuit and/or investigation:

- In the Matter of Certain Baseband Processor Chips and Chipsets, Transmitter and Receiver (Radio) Chips, Power Control Chips, and Products Containing Same, Including Cellular Telephone Handsets, U.S. International Trade Commission Case. No. 377-TA-543.

- *Broadcom Corp. v. Qualcomm, Inc.*, Civil Action No. 05-468 in the Central District of California

It has come to our attention that the following six (6) printed references submitted to the USPTO in the June 5 IDS were inadvertently submitted:

C27	"CDMA Digital CAI Standard, Cellular System Dual-Mode Mobile Station-Base Station Compatability Standard, Draft Rev. 0", 07/31/1990, Bates Nos. QBB138614-832
C28	"CDMA Digital CAI Standard, Cellular System Dual-Mode Mobile Station-Base Station Compatability Standard, Draft Rev. 1", 10/01/1990, Bates Nos. QBB138833-9249
C29	"CDMA Digital CAI Standard, Cellular System Dual-Mode Mobile Station-Base Station Compatability Standard, Draft Rev. 1.1", 07/15/1991, Bates Nos. QBB139250-858
C119	"Proposed EAI,TIA Standard, Cellular System CDMA-Analog Dual-Mode Mobile Station - Base Station Compatibility Standard, Rev. 1.12", 03/16/1992
C120	"Proposed EAI,TIA Standard, Cellular System CDMA-Analog Dual-Mode Mobile Station - Base Station Compatibility Standard, Rev. 1.13", 03/23/1992
C431	"Proposed EAI,TIA Standard, Cellular System CDMA-Analog Dual-Mode Mobile Station - Base Station Compatibility Standard, Rev. 1.14", 04/21/1992

Pursuant to 37 C.F.R. § 1.59(b), the Applicants hereby request that these six references, and all copies (whether paper or electronic) be expunged from the record and either destroyed or returned to the Applicants.

In support of this request, the Applicants note that this request is being made prior to the issuance of any patent on the application in issue. *See* MPEP § 724.05, paragraph (II)(A). Applicants state that the above-mentioned references submitted in the June 3 IDS were inadvertently submitted and, according to Qualcomm, Inc., the failure to obtain their return may cause irreparable harm to Qualcomm. *See* MPEP § 724.05, paragraph (II)(B). Further, according to Qualcomm's counsel, the above-mentioned references have not been made public. Rather, the above-mentioned references have been marked on their face as containing "QUALCOMM CONFIDENTIAL BUSINESS INFORMATION SUBJECT TO PROTECTIVE ORDER" and Qualcomm, Inc. has refused to de-designate the references. *See* MPEP § 724.05, paragraph (II)(C). Additionally, there is a commitment on the part of the petitioner's litigation counsel to retain such information for the period of any patent with regard to which such information is submitted. *See* MPEP § 724.05, paragraph (II)(D). Also, the Director should determine that the information to be returned is not material information under 37 CFR 1.56 at least because as stated in 37 CFR 1.56(b), "information is material to patentability when it is not cumulative to information already of record or being made of record in the application." We believe that at least some of the above-mentioned references may be earlier revisions of the publicly available published version that was submitted to the USPTO as:

C121	"Proposed EIA/TIA Interim Standard, Wideband Spread Spectrum Digital Cellular System Dual-Mode Mobile Station – Base Station Compatibility Standard", EIA/TIA/IS-95, 04/21/1992
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Thus, the C27, C28, C29, C119, C120 and C431 references are cumulative to the C121 reference. *See* MPEP § 724.05, paragraph (II)(E). The petition fee as set forth in 37 CRF 1.17(g) is included with this petition. *See* MPEP § 724.05, paragraph (II)(F).

For the convenience of the USPTO, it is noted that similar Petitions to Expunge Papers under 37 CFR § 1.59(b) are being submitted in the following applications:

- 10/631,071 (Attorney Docket No. 14406US02),
- 10/657,595 (Attorney Docket No. 14406US03),
- 11/009,338 (Attorney Docket No. 14406US04),
- 10/965,991 (Attorney Docket No. 14771US02),
- 11/474,907 (Attorney Docket No. 14771US03),
- 09/318,668 (Attorney Docket No. 14206US01),
- 10/630,138 (Attorney Docket No. 14206US02), and
- 10/657,785 (Attorney Docket No. 14206US03).

Please charge any fees incurred in connection with this submission to Deposit Account No. 13-0017 in the name of McAndrews, Held & Malloy, Ltd.

Respectfully submitted,

Date: November 7, 2007

/Philip Henry Sheridan/
Philip Henry Sheridan
Reg. No. 59,918

McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
(T) 312 775 8000
(F) 312 775 8100